

## REMARKS

Recognition of the existing specification and recognition the existing claims and action thereon, are respectfully requested.

This application, Ser. No. 09/845,999 was filed 9/24/01 as a continuation in part of application Ser. No. 09/313,566 filed 5/14/99 by the inventor, pro se.

A substitute specification (along with new claims numbered 1-22) was filed in the parent application on 9/5/00. However the specification was not entered by the Examiner per a 9/20/00 Office Communication, for the reason that "it does not conform to 37 CFR 1.125(b) because a statement as to a lack of new matter under 17 CFR 1.125(b) is missing and a marked-up copy of the substitute specification has not been supplied ... ."

Via a 10/4/00 dated Supplemental Amendment, applicant submitted a new marked-up copy of the Substitute Specification, and requested, inter alia, entry of the Substitute Specification attached to the Amendment filed 9/5/00.

A Power of Attorney to the undersigned was filed 10/23/00.

In response to an Office action mailed 10/30/00 and still refusing to enter the substitute specification because "the marked up copy was "not acceptable as such, since it does not show all of the deletions from and additions to ", applicant filed a SECOND SUPPLEMENTAL AMENDMENT, dated 11/14/00, attaching a marked-up, per 37 CFR 1.125(b), copy of the Substitute Specification, and requesting inter alia entry of the above mentioned Substitute Specification.

Per a THIRD SUPPLEMENTAL AMENDMENT dated January 23, 2001, and in response to the Examiner's telephone call, applicant canceled the claims existing at the time of the Office Communication mailed 6/15/00 and labeled "4 Figures - 22 Claims -- Figure 1: 1 through 7; Figure 2: 1 through 6; Figure 3: 1 through 4; Figure 4: 1 through 5."

In response to the FINAL REJECTION mailed 1/31/01 alleging, inter alia, that claims 21-42 contain "subject matter which was not described in the specification", applicant filed an AMENDMENT AFTER FINAL (dated March 3<sup>rd</sup>, 2001) proposing correcting amendments and/or disputing the Examiner's new subject matter opinions, and rewrote claims 21-42. In the Office Communication mailed 4/17/01, the Examiner refused entry of the amendments because "they raise new issues that would require further consideration and/or search".

Applicant then filed the continuation-in-part application on application 09/313,566 on 4/30/01, together with a PRELIMINARY AMENDMENT dated April 30, 2001 and which amended the substitute specification (attached to the Amendment filed 9/5/00 in parent application 09/313,566) and added an additional claim, claim 43.

A 7/20/01 NOTICE OF INCOMPLETE APPLICATION followed stating: "A complete specification as prescribed by 35 USC 112 is required". Applicant responded by filing a SECOND PRELIMINARY AMENDMENT dated September 19, 2001 to amend further the substitute Specification to reference the earlier application.

In response to a 9/19/01 telephone call from the Petitions Office of the Patent and Trademark Office, applicant filed a THIRD PRELIMINARY AMENDMENT dated September 20, 2001 that rewrote a new paragraph inserted via the SECOND PRELIMINARY AMENDMENT to read: "This application will utilize, and incorporate by reference, the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute part of the new application." This was to make clear that the parent application was incorporated by reference in the new application.

Via a DECISION GRANTING PETITION mailed May 20, 2002, the new application was accorded a filing date of September 24, 2001. The DECISION goes on to state:

"The 9/24/01 Third Preliminary Amendment specifically incorporates the disclosures in the parent application by reference, ... ."

"The petition also encloses a copy of the specification (4 pages including 22 claims) and drawings (1 sheet with 4 figures) from the parent application, No. 09/313,566, and a Declaration executed by the sole inventor on 11/25/01, subsequent to the 9/24/01 third Preliminary Amendment."

The continuation-in-part or new application thus included claims 21-42 of the old application, and the PRELIMINARY AMENDMENT of April 30, 2001 added a new claim 43.

Accordingly, applicant believes that:

1. a proper specification resides in the new application; and
2. a set of claims numbered 21 to 43 reside in the application, and not a set numbered 1-4.

Claim 43 has been above amended in line 3 by inserting "by" to correct an obvious omission.

Claims 1-4 were rejected under 35 USC 112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As noted above, claims 1-4 are not thought to exist in this application. As to claims 21-43, applicant urges that they are definite.

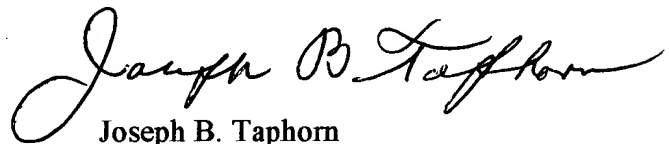
Claims 1-4 were rejected under 35 USC 102(b) as being anticipated by Echols. As noted above, claims 1-4 are not thought to exist in this application. As to claims 21-43 (parent application AMENDMENT AFTER FINAL dated March 11, 2001), applicant urges that they all contain limitations defining invention beyond what Echols teaches. For example, base claim 21 requires a rider recreational product having a wing and a fuselage or tail section for skimming on water and flying through the air and separable into two section, comprising a first section constituting the wing of the product and

independently usable as a rideable element, and a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski. Echols doesn't employ two sections, one being a rideable element and the other a surfboard of ski.

Base claim 38 is somewhat similar to claim 21. Independent claim 43 requires VELCRO-like engagement mechanisms not taught by the references.

Wherefore it is believed that this application is condition for allowance, which favorable action at an early date is earnestly solicited.

Respectfully submitted,



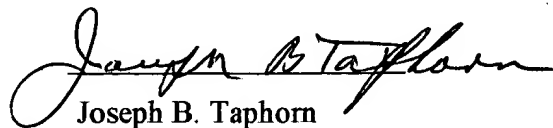
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CERTIFICATE OF MAILING - The undersigned certifies that this correspondence addressed to the Commissioner for Patents; P.O. 1450; Alexandria, VA 22313-1450; has been deposited in the United States Postal System as first class mail with sufficient postage on August 10, 2004.



Joseph B. Taphorn